Appln. No. 09/991,096
Amendment dated January 5, 2007
Reply to Office Action mailed November 7, 2006

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1 through 34 remain in this application. No claims have been cancelled, withdrawn, or added.

Paragraphs 2 and 3 of the Office Action

Claims 1 through 17, 19 through 26, 29 and 31 through 34 have been rejected under 35 U.S.C. §102(e) as being anticipated by Davenport.

Claims 18, 27 and 28 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Davenport as applied above and further in view of the Official Notice.

Claim 1 requires in part "a user personal computer configured to detect and upload data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*" (emphasis added).

Turning first to the "Response to Arguments" in the final Office Action, it is stated there that (emphasis added):

> In the remarks applicant argues in a substance that: A) Davenport does not teach detect and upload user interaction with personal computer *during an initial setup of the user personal computer.* B) Davenport does not teach detecting user interaction with personal computer.
> In response to A) Applicant is reminded that claim limitation must be given their broadest reasonable interpretation. Davenport teaches instrumentation session (session for detecting or recording users interaction or activities) <u>initiates when instrumented application begins execution</u> (See Column 7, lines 23-33). <u>Executing application</u>

Page 9 of 18

is broadly interpreted to be initial setup. Therefore teaching of
Davenport meets the claim limitation.

It appears from this statement in the rejection that that Examiner is broadly
interpreting *the disclosure of the Davenport patent,* and not the language of
the claim limitation. The Patent Office is not allowed to "broadly interpret"
the teaching of a reference in order to make it disclose more than it actually
does, or to effectively negate a claim limitation by ignoring what it
specifically requires. The question that must be asked is whether the
specific requirement of "user interaction with personal computer *during an
initial setup of the user personal computer*" is satisfied by what is actually
described in the Davenport patent (and not what it might be "broadly
interpreted" to teach, which appears to be the basis of a §103(a) rejection
and not the anticipation required by the pending §102(e) rejection.

Turning to the cited portion of the Davenport patent at col. 7, lines 23
through 33, it states that (emphasis added):

> The instrumentation session is the period of time during which the
> application is measuring parameters about the local computer.
> Initiation of the instrumentation session occurs when the application
> is ready to begin measuring parameters. The instrumentation session
> would normally be initiated when the instrumented application begins
> execution, although the session could well be initiated at a later point
> during execution of the instrumented application if the manufacturer
> wished to conduct measurements while only a certain section of the
> application was executing.

However, again, and as will be shown below, there is nothing here that
discloses detection of "user interaction with personal computer *during an
initial setup of the user personal computer*". Instead, what Davenport
discusses is the measuring and reporting parameters when an application
begins execution, but there is absolutely no discussion here that would tell
one of ordinary skill in the art that the "instrumented application" is in any
way equivalent to an initial setup of a personal computer. In fact, the
suggestion here is that the "instrumentation session could well be initiated
at a later point" than when the application being monitored begins. This

Appln. No. 09/991,096
Amendment dated January 5, 2007
Reply to Office Action mailed November 7, 2006

could only lead one of ordinary skill in the art to understand that it is not considered important that the "instrumentation session begin at *any* initialization, or initial setup, particularly of the computer itself.

The specific language of the claim that requires that the "data characterizing a user's interaction with the user personal computer" that is detected and uploaded regards interaction that occurs *"during an initial setup of the user personal computer"*. It is submitted that this requirement of claim cannot be ignored simply by "broadly interpreting" the Davenport patent to disclose more than it does, especially when the Examiner has not made any allegation of inherency or obviousness.

The Response to Arguments portion of the final Office Action further states:

> In response to B) Davenport teaches detecting users activities such as copy, cut, past etc (See Column 2, lines 41-60, Column 9, lines 20-26). Executing these commands by user in a computer is interpreted to be user's interaction with personal computer. Therefore, teaching of Davenport meets the claim limitation.

Again looking to the text of the Davenport patent, it states at col. 2, lines 41 through 60 that (emphasis added):

> To address these and other needs, the present invention provides a method for enabling a software manufacturer to record a set of data points about a computer while it is executing an application. The data points contain <u>measurements concerning a status, condition, action, event or other measurable property about the computer</u>. The data point information is thereafter transmitted to a central computer for analysis so that the manufacturer can obtain timely and precise feedback about how its application is being used. The method of the present invention is thus well-suited to obtaining and processing computer usage information involving millions of computers.
> The present invention is accomplished by executing on a local computer, such as one belonging to a customer, a software program that has been adapted to <u>measure predetermined parameters about the usage, performance or status of the computer</u> on which the application is running. Such an application is hereinafter termed an "instrumented application."

Page 11 of 18

And in Davenport at col. 9, lines 20 through 26 states:

> To adapt an application for the present invention, the software manufacturer would insert additional source code statements into the application's source code to <u>measure the parameter at the point during execution when measurement of the selected parameter is desired</u>. For example, a statement could be inserted at the logical beginning of the application's source code to <u>measure the local computer's total random access memory</u> and to obtain a value thereof shortly after execution begins.

Nothing in these cited portions of the Davenport patent provide any support for the statement in the Office Action that "Davenport teaches detecting user activities such as copy, cut, past[e], etc.", although it is noted that col. 9, lines 9 through 10 it is stated that parameters might include "[t]he number of times that a user clicked on a given user interface element, such as cut, copy, paste, etc". (The body of the rejection attempts to equate these buttons with a "help" button, but nothing here leads one of ordinary skill in the art to recognize that these actions are equivalent with the activating a "help" button.) The text in these portions broadly mentions "status, condition, action, event or other measurable property about the computer", as well as "parameters", and gives the specific example of "measur[ing] the local computer's total random access memory". This specific example does not disclose or suggest to one of ordinary skill in the art "user interaction", as the amount of "total random access memory" has nothing to do with user interaction, especially user interaction during an initial setup of the user personal computer" as required by the claims. Again, it appears that the Patent Office is broadly interpreting the disclosure of the Davenport patent to include elements that are not actually disclosed, rather than simply broadly interpreting the language if the claims.

Turning to the main contentions of the rejections in the final Office Action, it is contended that the Davenport patent teaches this requirement of claim 1 at col. 2, line 41 through col. 3, line 25 and at col. 11, line 33

through col. 12, line 16, alleging that "Davenport discloses a system capable of detecting user interaction with a computer and uploading that data." However, it is submitted that 1) the language of claim 1 does not merely require a system merely "capable of" detecting user interaction (but instead requires "a user personal computer *configured to* detect and upload data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*"), that 2) the Davenport patent makes no mention or suggestion of detecting *user interaction* with the personal computer, and that 3) the Davenport patent makes no mention or suggestion of any detecting or uploading of data that characterizes "a user's interaction with the user personal computer *during an initial setup of the user personal computer*". More specifically, and turning to the first cited portion of the Davenport patent at col. 2, line 41 through col. 3, line 25, it states (emphasis added):

> To address these and other needs, the present invention provides a method for enabling a software manufacturer to record a set of data points about a computer while it is executing an application. The data points contain measurements concerning a status, condition, action, event or other measurable property about the computer. The data point information is thereafter transmitted to a central computer for analysis so that the manufacturer can obtain timely and precise feedback about how its application is being used. The method of the present invention is thus well-suited to obtaining and processing computer usage information involving millions of computers.
>
> The present invention is accomplished by executing on a local computer, such as one belonging to a customer, a software program that has been adapted to measure predetermined parameters about the usage, performance or status of the computer on which the application is running. Such an application is hereinafter termed an "instrumented application." The parameters to be measured are determined by the software manufacturer and could include information such as the processor speed of the computer system, the amount of its random access memory or the speed of the computer's Internet access. Upon execution, the instrumented application initiates an instrumentation session and obtains an identifier. The identifier is an alphanumeric or numeric value that identifies the local computer user or the local computer itself. The instrumented application then measures the predetermined parameter to obtain a value and stores a data point on the computer identifying the parameter and the value. The present invention contemplates data points that store a single value as well as a series of values. A single value data point records a numeric or alphanumeric value, such as the amount of the computer's random access memory (RAM). A series of values, or stream, data point contains a series of numeric or alphanumeric values whereby the order of the values within the stream indicates the order in which the events or other parameters occurred, such as a list of clickable links the user

Page 13 of 18

selected. Additionally, data points in either form may be supplied with a time stamp indicating the time at which the data point was measured. <u>Parameters can be measured until the instrumentation session ends, which occurs when the user exits from the instrumented application or as otherwise provided by the software manufacturer.</u>

When an instrumentation session ends, the identifier and the data points collected during that session are saved in a session file on the local computer. The method of the present invention then attempts to transmit the session file to an upload server computer for further processing. If the session file is transmitted, it is then deleted from the local computer; otherwise, the session file is retained for possible later attempted transmission.

However, nothing here discloses or suggest that the Davenport system "detect[s] and upload[s] data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*", as required by claim 1. The examples given in the text (and highlighted above) relate to the performance of the computer ("processor speed", "amount of its random access memory" and "speed of the computer's Internet access") and not to the *user's interaction* with the personal computer, as these examples are things that are basically independent of the user's actions. Nor are the examples given directed to user interaction occurring "during an initial setup of the user personal computer" as also required by claim 1. Furthermore, the Davenport "data points" are measured "until the instrumentation session ends", which suggests to one of ordinary skill in the art that there is no particular stage of operation when the data points are measured. It is submitted that the examples given are more likely to lead one of ordinary skill in the art *away from* the claimed user interaction with the computer during an initial setup" rather than leading one to this requirement. The rejection of the Office Action further references the Davenport patent at col. 11, line 33 through col. 12, line 16, where the Davenport patent states:

At step 250, the instrumentation session is complete, and the instrumented application ends the instrumentation session by ceasing to measure parameters for this instrumentation session. The application thereupon saves the set of data points along with the identifier in a session file on a local storage device accessible by the local computer. The local storage device may be the hard disk of the local computer, a removable memory device associated with the local computer or other storage medium associated with the local computer. The local storage device could likewise be a storage device to which the local computer has access via a network, such as on a LAN server. As will be appreciated by

Page 14 of 18

those skilled in the art, the session file could be further subjected to file compression to decrease transmission times.

The session file could further be named to facilitate management of session files awaiting transmission to a remote computer. For example, the session file could be stored as a file named SESSIONnnn.DAT, where -nnn- represents a number between a selected range, such as 1 and 10. The range can be selected to correspond to the maximum number of untransmitted session files to be stored at any one time on the local storage device. When a new session file is to be saved, the instrumented application would use an available file name. Thus, when the instrumented application seeks to store a current session file and, for example, the file SESSION001.DAT already exists, the instrumented application could save the current session file to SESSION002.DAT if no existing file had yet used this name. If the maximum number of stored session files had been reached, the instrumented application could delete the file containing the oldest session data and store the current session file, thereby conserving disk space.

After the session file has been stored, control passes to step 252 at which point the application directs the local computer to transmit the current session file to a remote computer or upload server 206 via a network, such as network 204. The network could be a local area network or a wide area network, such as the Internet. As will be understood by those skilled in the art, the transfer could be accomplished expeditiously using an HTTP POST or HTTPS POST request to the upload server 206 that transmits the data in binary form. The application determines at step 254 whether the session file was transmitted to the remote computer. If so, control passes to step 256 and the session file is deleted from the local storage device to conserve storage space. If the transmission of the current session file did not occur, it is retained on the local storage device so that when the next instrumentation session is started, a further attempt at transmission of this session file can be made. Regardless of whether the session file is transmitted, control passes to step 258 at which point processing is completed.

Again, nothing here describes or suggests that there is any detection or unloading of "data characterizing a user's interaction with the user personal computer *during an initial setup of the user personal computer*". In fact, the text here (especially in combination with the text cited above) leads one of ordinary skill in the art to believe that the "data points" that are recorded occur after any initial setup of the computer, as the detection of processor speed and Internet access speed are certainly more meaningful after an initial setup than during an initial setup of the personal computer. (A review of the disclosure of the provisional patent application fails to show any further description that would lead one of ordinary skill in the art to the elements of claim 1 that are missing in the Davenport patent.)

It is therefore submitted that the Davenport patent could not lead one

Page 15 of 18

of ordinary skill in the art to the combination of requirements of claim 1,
particularly the elements addressed above.

Similarly, claim 10 requires in part "a user personal computer
configured to detect and upload data related to a user's out-of-box
interaction with the user personal computer during initialization". Claim 12
requires "providing the user personal computer with a capability of
detecting data related to a user's interactions with the personal computer",
"initializing the user personal computer including user interaction detecting
capability, by the user", and *"detecting, during the initializing by the user,
data related to the user's interactions with the personal computer during
initialization"* (emphasis added). Claim 20 requires *"detecting an
initialization* of a user when the user sets up a user personal computer",
"saving the initialization activity detected in said detecting step *to a file"*
and *"uploading the file* to an originator of the user personal computer
wherein the initialization activity of the user is correlated by the
originator" (emphasis added). Claim 22 requires "a second software
program configured to cause the user personal computer to *detect and
compile the user's initial interactions* with the personal computer
performing the first software program" and "wherein the second software
program is configured to cause the user personal computer to upload the
compiled data to a remote information handling system". Claim 23 further
requires "means for detecting *an initialization activity* of a user when the
user initializes a personal computer", "means for *saving the initialization
activity detected* by said monitoring means to a file", and "means for
uploading the file to an originator of the user personal computer wherein *the
initialization activity of the user is correlated by the originator"* (emphasis
added).

With respect to claim 27, which requires "wherein the data related to
the user's interaction includes a screen capture", it is alleged in the
rejection that:

Page 16 of 18

> Davenport does not explicitly teach the claim limitation of screen capture.
> However, "Official Notice" is taken that screen capture is old and well known in the art.
> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Davenport by adding screen capture, which will provide more user's interaction with the system to manufacturer. One would be motivated to do so to enhance the system's performance.

The assertion that "screen capture is old and well known in the art" is challenged, in as much as it is not believed that it is old and well known to capture a screen shot as part of data relating to user interaction during an initial setup of a computer. Further, assuming for the purpose of argument only that the contention that such is old and well known, it is submitted that one of ordinary skill in the art would not be motivated to make the suggested modification of Davenport simply "to enhance the system's performance", as alleged in the Office Action. The "motivation" of "enhancing system performance" might be alleged to support any number of changes to the Davenport system, but the rejection points to nothing in the prior art that leads one of ordinary skill in the art to understand that this particular modification would "enhance system performance".

With respect to claim 28, which requires "wherein the data related to the user's interaction comprises data about a time period that a dialog box is open during the initial setup of the user personal computer", it is asserted in the rejection of the Office Action that:

> However, "Official Notice" is taken that data about a time period that a dialog box is open is old and well known in the art.
> It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Davenport by adding functionality for collecting data about a time period that a dialog box is open, which will provide more user's interaction with the system to manufacturer. One would be motivated to do so to enhance the system's performance.

The assertion that "data about a time period that a dialog box is open is old and well known in the art" is challenged, as it is not believed that it is old

Appln. No. 09/991,096
Amendment dated January 5, 2007
Reply to Office Action mailed November 7, 2006

and well known to monitor or collect data regarding how long a dialog box is open. Further, and again assuming for the purpose of argument only that the contention that such is old and well known, it is submitted that one of ordinary skill in the art would not be motivated to make the suggested modification of Davenport simply "to enhance the system's performance", as alleged in the Office Action. As noted above, the "motivation" of "enhancing system performance" may be used to justify any number of changes to the Davenport system, but the rejection points to nothing in the prior art that leads one of ordinary skill in the art to understand that this particular modification would "enhance system performance".

It is therefore submitted that the Davenport patent and the Official Notice would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1 through 34.

Withdrawal of the §102(e) and the §103(a) rejections of claims 1 through 34 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.

(signature)

Date: Jan. 5, 2007
_____
Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. **40,158**
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357

Page 18 of 18

PAGE 19/19 * RCVD AT 1/5/2007 4:15:47 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/21 * DNIS:2738300 * CSID:605 339 3357 * DURATION (mm-ss):03-08